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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,037	12/28/2001	Daniel L. Cox	ACS 58088	9178
24201 7590 03/31/2004 FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER HO, UYEN T	
			ART UNIT 3731	PAPER NUMBER

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,037

Applicant(s)

COX, DANIEL L.

Examiner

(Jackie) Tan-Uyen T. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 34-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/15/02, 7/15/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-66, drawn to an intravascular stent, classified in class 623, subclass 1.15.
 - II. Claims 70-77, drawn to method for forming the stent, classified in class 623, subclass 1.15.
 - III. Claim 78, drawn to method of crimping the stent on a balloon, classified in class 623, subclass 1.11.
 - IV. Claim 79, drawn to method of delivering the stent, classified in class 623, subclass 1.11.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II or III or IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus or by hand and the apparatus as claimed can be used to practice another and materially different process.

3. Inventions II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are different methods so they have different modes of operation, different functions and effects.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1: stent (claims 1-33, 67-69); Species 2: stent (claims 34-41, 70-72); Species 3: stent (claims 42-49, 73); Species 4: stent (claims 50-67, 74-77).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 78 and 79 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Mr. John Nagy on 3/23/2004 a provisional election was made without traverse to prosecute the invention of Group I, Species I, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-79 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on 4/15/02 and 7/15/03 have been considered.

Specification

8. The abstract of the disclosure is objected to because it contains phrases, which can be implied for example, "The invention is directed...." Correction is required. See MPEP § 608.01(b).

9. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

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on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation "longitudinal resistance to bending" in 1 and 2. Claim 5 recites the limitation "radial resistance to compression is at least equal to a metallic stent...." The Examiner does not know and understand the longitudinal resistance to bending or radial resistance to compression of what comparing to a metallic stent.

Drawings

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the slots on the outer surface of the coil must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-3, 6, 8, 10-27 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kocur (6,350,277).

In regard to claim 1, Kocur disclose a stent (figure 7) including a plurality of metallic rings and a polymeric coil (115).

In regard to claims 2 and 3, Kocur disclose the coil attached on the outside surface of the stent or being interwoven around the circumference of the stent, weave in-between struts (col. 4, lines 14-17.) or inside of the stent (col. 5, line 66 to col. 6, line 4).

In regard to claim 6, the rings and the coil as disclosed by Kocur are continuously coupled together in both the first delivery diameter and second implanted diameter (col. 6, lines 61-67, figures 13a-13d).

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In regard to claim 8, wherein the rings are attached to the coil with a bonding agent (col. 6, lines 5-60)

In regard to claim 10, wherein the coil radially compresses when the stent is crimped onto a catheter (col. 6, lines 5-60)

In regard to claims 11 and 12, the rings and coil are made from the materials as claimed (col. 8, line 61-67 and col. 7, lines 1-60).

In regard to claims 13, 15-23, wherein the rings have configurations and are made from materials as claimed (figures 7-9, col. 8, lines 61-67).

In regard to claim 14, the rings are bonded to the coil at points in between the peaks and valleys of the rings (see alternative points of connection between the rings and the coil in figures 13a-13d).

In regard to claims 24-27 and 33, the coil is treated/coated with therapeutic agents (col. 8, lines 12-60) and the stent is made from non-biodegradable and biocompatible material (col. 8, line 61 to col. 9, line 10, see the materials of the patents that are the incorporated).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 7, 9 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocur (6,350,277).

In regard to claim 7, although Kocur fails to disclose a plurality of protrusions extend radially outward of the cylindrical rings in a second implanted diameter, it is known in the art to employ anchors at least on the two ends of the stent such that the anchors extending radially outward in an implanted diameter of the stent in order to anchor the stent in place. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ anchors at least on the two ends of the Kocur's stent such that the anchors extending radially outward in an implanted diameter of the stent in order to anchor the stent in place.

In regard to claim 9, although Kocur fails to disclose the attachment of the rings and the coil via the slots on the outer surface of the coil, it would have been obvious matter of design choice to modify the Kocur reference by having slots on the outer surface of the coil for the rings to attach thereto, since the applicant has not disclosed that having the coil including slots for attaching to the ring would solves any stated problem or is for any particular purpose and it appears that the coil and the rings would perform equally well with the attachment of the rings and coil via adhesive material or the slots on the surface of the coil.

In regard to claims 29-32, although Kocur fails to disclose the rings or the coil including material therein to enhance the radiopacity of the stent, it is known in the art to employ radio-pique material on the stent to enhance the radiopacity of the stent in order to locate, navigate the stent to a treated site in a body lumen.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Patent Examiner
Art Unit 3731
March 24, 2004